

REMARKS

Claims 1-3, and 6-8 are pending in the present application. Support for the changes to claim 1 is found at page 11, lines 2-7 of the specification.

It is respectfully requested that the changes to claim 1, as well as the cancellation of claims 4, 5, 9 and 10, be entered of record and considered by the Examiner. The changes to claim 1 essentially amount to the incorporation of previous claim 5 into claim 1, along with a narrowing of the types of cosmetic formulation components fully supported at the top of page 11 of the specification. The cancellation of various claims reduces the total number of claims for consideration. It is submitted that all of these changes do not present any additional significant issues before the Examiner. Thus, it is respectfully submitted that all of these claim changes should be considered as proper and at least place the present claims into better form for consideration on appeal, should an appeal be necessary, under 37 CFR 1.116(b).

Removal of Rejection of Cancelled Claims 9 and 10

Claims 9 and 10 were rejected under 35 USC 112, first paragraph, for the reasons indicated at pages 2-3 of the Final Office Action dated November 12, 2009. Claims 9 and 10 have been cancelled so as to remove the basis for this rejection which should now be withdrawn.

Issues under 35 USC 103(a)

Claims 1-6, 9 and 10 have been rejected under 35 USC 103(a) as being unpatentable over Velisek et al. (Journal of Food Science, volume 56, no. 1, 1991, pp. 139-142), in view of Carrell '808 (US 5,514,808). Claims 9 and 10 have been cancelled.

Claims 7 and 8 have been rejected under 35 USC 103(a) as being unpatentable over Velisek et al. in view of Carrell '808 and further in view of Berge (J. Pharmaceutical Sciences, 1977).

These rejections are traversed based on the reasons below.

Summary of Position of Patent Examiner

It is essentially the position of the Patent Examiner that the recitation in the preamble of the present claims that the claimed composition is a “cosmetic”, as well as the later recitation in claim 1 of this term, fail to have any “patentable weight” so as to fail to provide any significant distinction over the Velisek et al. reference. The Examiner further maintains her position that the food-related disclosure of Velisek et al. can be combined with the wound treatment compositions described by Carrell '808, despite the fact that the food-related technical field and wound treatment technical field are not reconciled in the Final Office Action, and despite the fact that Carrell '808 fails to disclose any compounds falling within formula (I) recited in the present claims. Also, the Examiner refers to Table 1 in Velisek et al. for amounts of N-(2,3-dihydroxypropyl)-glycine to reach 1-14% since the amount shown in this Table at page 139 ranges as high as 144 mg/g of this compound formed with respect to the amount of glycine used.

Distinctions over Cited References

Velisek et al. is directed to the use of amino acid derivatives, and the identification thereof in protein hydrolysates, in connection with “foodstuffs” or “seasonings for improvement of flavor of many foods” as noted at the end of the abstract and at the beginning of the introduction thereof. This is not surprising as the journal is the “Journal of Food Science”. Regarding the disclosures of the amounts of the various described compounds, Velisek et al. discloses at page 139 that “glutamic acid” is present in an amount “reaching about 15% (dry basis)”; and that, “...the content of 3-chloro-1,2-propanediol [in protein hydrolysates] often reaches several hundred ppm (mg·kg⁻¹)...” These disclosed amounts do no relate to the described amino acid derivatives, but rather precursors thereof. There is no specific disclosure in Velisek et al. at pages 139-141 of any compositions containing a particular amount of the described amino acid derivatives. Note that the amounts in Table 1 at page 139 of Velisek et al. are yield amounts of N-(2,3-dihydroxypropyl)-glycine formed with respect to glycine and do not refer to a composition content amount. At page 142, Velisek et al. discloses that hydrolysates treated with 3-chloro-1,2-propanediol and heat can contain up to 10 mg·kg⁻¹ of the described amino acid derivatives. This equates to about 0.001% by weight.

Velisek et al. fails to disclose or suggest a cosmetic composition containing the claimed N-glyceryl derivative as recited in the present claims. Velisek et al. is directed to employment of the described amino acid derivatives in food. The disclosures in Velisek et al. of the amounts of the described amino acid derivatives do not appear to reach significantly above about 10 mg·kg⁻¹ which corresponds to about 0.001% by weight. Further, one skilled in the art would not modify the food-related compositions of Velisek et al. to significantly increase the amount of the described amino acid derivatives by about 50 times, as there is no suggestion to do so. Also, Velisek et al. does not relate to a cosmetic composition which further undermines a basis for modifying the compositions described therein in order to obtain the cosmetic composition of the present invention. Consequently, significant patentable distinctions exist over Velisek et al. such that the rejection based thereon should be withdrawn.

Carrell '808 relates to the use of hydroxyl ions in combination with hydroxyl ion modulating compounds derived from tertiary amines for therapeutic treatment, especially the treatment of wounds, wherein the modulating compounds fall within the formula at the top of column 4. The entire disclosure of Carrell '808 is directed to using the modulating compounds together with hydroxyl ions that cause "severe toxicity and tissue irritating effects" (col. 1, lines 14-15). Also see col. 4, lines 31-37. It is clear that Carrell '808 requires the presence of a significant amount of an hydroxyl ion component in order to achieve the clear "intended purpose" of the described therapeutic applications, since an insignificant amount would not allow one could not obtain the beneficial effects of this component in combination with the modulating compounds.

Carrell '808 fails to disclose any compounds within formula (I) of the present claims directed to cosmetic compositions. For example, Example 8 of Carrell '808 is a tertiary amine which differs from the presently claimed secondary amine compounds of formula (I) of the present invention wherein X is hydrogen. Further, all of the hydroxyl ion modulating compounds disclosed by Carrell '808 are N,N-disubstituted-aminoacetate compounds, with no N-monosubstituted-aminoacetate compounds corresponding to those of formula (I) of the present claims being disclosed. Thus, significant structural distinctions exist between the compounds of formula (I) of the present claims and the compounds disclosed by Carrell '808.

In addition to the above, the compounds of formula (I) of the present claims may be advantageously employed in a cosmetic, such as a hair cream, in order to provide enhanced moisture absorption, moisturizing effects, gloss, moist feel, smoothness, and combatability (i.e. “combing ease”) as evidenced by the test results shown in Tables 1, 4, 6, 8, 10, 12, 16 and 19 in the present specification. Note that these effects may be obtained without requiring alkaline conditions, as all of the examples in the present specification mentioned above were conducted under neutral conditions. In contrast, Carrell '808 discloses the described compounds for use under alkaline conditions together with hydroxyl ions for “wound treatment”. Further, Carrell '808 fails to recognize any of the unexpected, advantageous cosmetic properties noted above with respect to the compounds of formula (I) of the present invention. Consequently, significant patentable distinctions exist between the presently claimed invention and Carrell '808 such that the above-noted rejection must be withdrawn. Further, there fails to be any basis disclosed in Carrell '808 which provides any motivation to one skilled in the art to attempt to obtain the compounds of the present invention.

Carrell '808 cannot be combined with Velisek et al. in view of the significantly inconsistent applications each addresses. Carrell '808 describes compositions used in wound treatments requiring that are clearly not edible, whereas in contrast, Velisek et al. is directed to foodstuffs and food flavor enhancers. There is no evidence in the record to suggest that one skilled in the art would take selectively combine features from compositions used in wound healing and compositions used in consumable food products. Thus, these references cannot be combined, such that the above rejection cannot stand and must be withdrawn. Still further, note that a person skilled in the art must make several modifications without any basis in an attempt to selectively combine unique components from each reference so as to arrive at the presently claimed invention. One would have to exclude the hydroxyl ion component of Carrell '808 which would be inconsistent with a cosmetic having formulation components used on hair, for example, and not exhibiting “wound treatment” properties. One would not even use any of the hydroxyl ion modulating compounds of Carrell '808, since none fall within formula (I) of the present claims. One would have to ignore the fact that Velisek et al. is directed to the use of the disclosed amino acid derivatives in “foodstuffs” and flavoring agents in order to form a

composition based on Carrell '808 directed to "wound treatment" compositions. In the end, a composition that does not serve either the purpose of Velisek et al. or Carrell '808 would be formed without any reasonable basis for doing this.

Berge et al. is cited for its disclosure of pharmaceutical salts. Berge et al. fails to make up for the deficiencies noted above with respect to Velisek et al. and Carrell '808, such that the above rejection including this references still fails and must be withdrawn.

It is submitted for the reasons above that the present claims define patentable subject matter such that this application should now be placed in condition for allowance.

If any questions arise in the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By _____
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